

**REMARKS**

Claims 1-23 remain pending in the present application.

**Claims 1, 4-6, 8, 12, 15, 16, 20 and 23 over Tanaka**

In the Office Action, claims 1, 4-6, 8, 12, 15, 16, 20 and 23 were rejected under 35 USC 102(e) as allegedly being anticipated by U.S. Pat. No. 6,542,749 to Tanaka ("Tanaka"); claims 2, 3, 9-11, 14, 17-19 and 22 were rejected under 35 USC 103(a) as allegedly being anticipated by Tanaka in view of U.S. Pat. No. 6,622,018 to Erikson ("Erikson"); and claims 13 and 21 were rejected under 35 USC 103(a) as allegedly being anticipated by Tanaka in view of U.S. Pat. No. 6,650,894 to Berstis ("Berstis"). The Applicant respectfully traverses the rejections.

The main reference used by the Examiner in rejecting all claims is Tanaka. The Examiner alleges that Tanaka teaches a reminder application that is triggered when a first mobile unit is in close proximity to a second mobile unit, citing Tanaka, col. 7, lines 1-10; col. 14, line 60 to col. 15, line 48; and col. 17, lines 1-55. (Office Action at 2)

Tanaka is not prime facie prior art with respect to the claims of the present invention.

In particular, the present application was filed on November 9, 2000, before the effective filing date of the changes to 35 USC 102(e). The Examiner's own instructions on page 2 of the Office Action indicate that the prior art date of the reference is determined under 35 USC 102(e) prior to the amendment by the AIPA. Pre-AIPA 35 USC 102(e) read as follows:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Tanaka was issued from an “application for patent” filed on June 8, 2001, which was nearly 7 months after the filing date of the present application for patent was filed.

Tanaka apparently claims priority from four separate provisional applications, none of which are an “application for patent” as no patent would issue from those applications.

Moreover, even if Tanaka were to be somehow presumed to have been an “application for patent” filed on the dates that any of the four provisional applications were filed (which would be improper), the Examiner provides no prima facie evidence that the cited passages at col. 7, lines 1-10; at col. 14, line 60 to col. 15, line 48; AND at col. 17, lines 1-55 (Office Action at 2) are all contained within any of the provisional applications.

If the Examiner were to rely on subject matter within any of the provisional applications bearing an earlier filing date than the present application, then such provisional application must be formally cited, and the Applicant must be given a copy of such provisional application to have the ability to respond thereto.

Lastly, even if the Examiner were to improperly consider Tanaka’s **provisional** applications to be an “application for patent” as required by 35 USC 102(e), and even if such provisional application were to contain the subject matter cited by the Examiner at col. 7, lines 1-10; at col. 14, line 60 to col. 15, line 48; AND at col. 17, lines 1-55, Tanaka still fails to disclose, teach or suggest the present invention.

In particular, the claims of the present application require a **reminder** that is **triggered** by a **detected proximity** to another wireless device.

Tanaka discloses a method and system for **connecting** proximately located telecommunications units. (Tanaka, Abstract) According to Tanaka, a caller requests a computer system 210 to select callees based on the closest members of a pre-selected list. (See, e.g., Tanaka, col. 5, lines 47-55) The caller initiates this request. There is **no reminding** involved.

Moreover, Tanaka’s request is not only **not a reminder**, but also not triggered by detected proximity. The caller triggers it. The particular members of

the call according to Tanaka are not known-they are selected by whomever is closest. The present invention relates to a reminder based on a detected proximity of another wireless device relevant to the reminder.

Erekson is cited by the Examiner for allegedly teaching determining a presence of a wireless device in a wireless network. The rejection based on Erekson using Tanaka as a base reference cannot stand on Erekson alone.

Berstis is cited by the Examiner for allegedly teaching disabling an alert when a particular PDA device is in close proximity. The rejection based on Berstis using Tanaka as a base reference cannot stand on Berstis alone.

For at least all the above reasons, claims 1-23 are patentable over the prior art of record. It is therefore respectfully requested that the rejections be withdrawn.

#### **Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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